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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,073	07/16/2001	Suguru Tsuchiya	P20746	5981
7055	7590	03/28/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			NGUYEN, MADELEINE ANH VINH	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/905,073

**Applicant(s)**

TSUCHIYA, SUGURU

**Examiner**

Madeleine AV Nguyen

**Art Unit**

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/24/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the signature of the inventor is missing.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 4-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Mori (US Patent No.6,384,927).

Concerning claim 1, Mori discloses a facsimile apparatus or a repeater (FI1 or FI2, Fig.1; Fig.2) comprising an input unit (7 or 11) that inputs an identifier of a repeater (corresponding mail address in Figs.3) and a plurality of sub-addresses (sub-address numbers in Figs.3, 13) of receiver terminals in association with the identifier; communication means (for calling a repeater (FI2) when a multicasting instruction is given; and a controller (1), upon receiving a multicast

Art Unit: 2626

instruction, that performs call processing for the repeater based upon the identifier and transmits the plurality of sub-addresses to the repeater (FI2), together with image information in a single communication transaction (Figs.9-12; 14-26; Abstract; col. 3, line 30 – col. 6, line 5; col. 8, line 52 – col. 9, line 62; col. 10, line 27 – col. 12, line 46; col. 15, lines 30-67; col. 17, line 44 – col. 18, line 6).

Concerning claim 2, the input unit further inputs a plurality of identifiers of repeaters (for registration), each of the plurality of identifiers being associated with at least one of the plurality of sub-addresses (Figs.3, 13), and wherein, when the plurality of identifiers of repeaters are input, the controller groups the plurality of sub-addresses input from the input unit by the repeaters based upon the identifiers and transmits each of the grouped sub-addresses to each of the repeaters (Figs.22-25).

Concerning claim 4, the plurality of sub-addresses input from the input unit are transmitted to the repeater by NSS (col. 10, lines 54-58).

Concerning claim 5, the identifier is a telephone number of the repeater (internet facsimile machine FI1 or FI2).

Concerning claims 6, 7, Mori discloses a repeater (FI1, Fig.1; Fig.2) comprising a receiving section (11) that receives a plurality of sub-addresses of receiver terminals from a telephone line, together with image information requested to be relayed in a single communication transaction; a memory section (3) that stores sub-addresses of receiver terminals and TCP/IP addresses (or email addresses) of the receiver terminals in association with each other; a controller that, when the plurality of sub-addresses of receiver terminals are received together with the image information, obtains a TCP/IP address (or an email address)

Art Unit: 2626

corresponding to each of the received sub-addresses of receiver terminals by referring to the memory section (Figs. 3, 13) and transmits the image information to a receiver terminal corresponding to the obtained TCP/IP address by an email including the obtained email address in an addressee field to a mail server (Figs.9-12; 14-26; Abstract; col. 3, line 30 – col. 6, line 5; col. 8, line 52 – col. 9, line 62; col. 10, line 27 – col. 12, line 46; col. 15, lines 30-67; col. 17, line 44 – col. 18, line 6).

Claims 8-9 are method claims of apparatus claims 1-2. Claims 8-9 are rejected for the same rationale set forth for claims 1-2 respectively.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori as applied to claim 1 above, and further in view of Izawa et al (US Patent No. 4,754,335).

Concerning claim 3, Mori fails to teach a plurality of one-touch buttons with which an identifier of a repeater and a sub-address of a receiver terminal can be input in one operation. Izawa et al discloses a facsimile apparatus (Figs.1, 4) comprising a memory (55) having a plurality of memory areas each storing telephone number data, different group of data, a plurality of one-touch buttons (key-in units) for selecting the destination data, group of destinations in one operation (Figs.4-9; Abstract;). The controller 51 can obtains the plurality of telephone numbers

Art Unit: 2626

of the receiver terminals in accordance with pressed one-touch buttons, and groups the plurality of the telephone numbers of the receiver terminals in association with each of the groups (col. 3, line 38 – col. 6, line 2). It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of Izawa, as a matter of well known in the art, to the facsimile apparatus in Mori in order to execute the transmission or reception, based on the plurality of telephone number data items assigned to the one-touch buttons.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori in view of Izawa et al.

Concerning claim 10, Mori discloses a facsimile apparatus as discussed in claims 1-2 above. Mori fails to teach a plurality of one-touch buttons with which an identifier of a repeater and a sub-address of a receiver terminal can be input in one operation. The same discussion is repeated as in claim 3 above.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

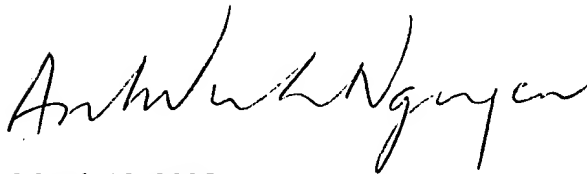
a. Bell et al (US Patent No. 5,659,542) discloses a system for selectively establishing user information over an information transport network.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 9:30-6:00.

Art Unit: 2626

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on 703 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2626

March 10, 2005